

**REMARKS**

At the time of the Office Action dated July 12, 2006, claims 13-24 were pending in this application. In this Amendment, claims 13-24 have been canceled, without prejudice, reserving right to prosecution in a continuation application, and new claims 25-36, corresponding to original claims 1-12, respectively, have been added to reinstate the original claims. Care has been exercised to avoid the introduction of new matter. A Request for Continuing Examination is filed herewith.

**Claims 13-24 have been rejected under 35 U.S.C. §102(e) as being anticipated by Shiraishi.**

This rejection has been rendered moot by cancellation of the claims 13-24. Withdrawal of the rejection is, therefore, respectfully solicited.

**New claims 25-36**

Applicants submit that Shiraishi does not disclose an ink feeding rate control method including all the limitations recited in independent claim 25 which requires “determining an average of image area ratios of images in the areas on said prints corresponding to said ink keys” (Requirement A), and “determining an average of image area ratios of images in positions aligned in a printing direction with said detecting patches printed in the areas on said prints corresponding to said ink keys” (Requirement B). For example, according the specification and Fig. 11 of the present application, the “areas” in Requirement A correspond to areas E1 and E2, the “positions” in Requirement B correspond to areas e1 and e2, and the “detecting patches” in Requirement B correspond to detecting patches P1-P4 in areas E1 and E2. According to claim

25, the “areas” (E1 and E2) corresponds to respective ink keys (see the preamble), and the “positions” (e1 and e2) and the “detecting patches” (P1-P4) are included in the “areas” (see Requirements A and B).

It is Applicants’ understanding of the Examiner’s position in the present Office Action that the “first areas” on page 3, line 5 of the Office Action correspond to Shiraishi’s areas  $r_{11}$ - $r_{14}$ ,  $r_{21}$ -24,  $r_{31}$ -34,  $r_{41}$ -44, and  $r_{51}$ -54 ; and the “second areas” on page 3 line 7 of the Office Action correspond to Shiraishi’s areas  $r_1$ - $r_4$  which are respectively aligned with ink key regions  $d_{a1}$ - $d_{a5}$ . See Fig. 7 of Shiraishi. However, Fig. 7 of Shiraishi does not disclose the claimed “detecting patches” in Requirement B with which the claimed “positions” are aligned. Furthermore, Shiraishi does not disclose the “areas” in Requirement A because areas  $r_{11}$ - $r_{14}$ ,  $r_{21}$ -24,  $r_{31}$ -34,  $r_{41}$ -44, and  $r_{51}$ -54 of Shiraishi do not include respective areas  $r_1$ - $r_4$  as well as the “detecting patches,” as claimed.

Accordingly, Applicants submit that Shiraishi does not disclose an ink feeding rate control method including all the limitations recited in independent claim 25. The above discussion is applicable to independent claims 29, 31, and 33. Dependent claims 26-27 and 34-36 are also patentably distinguishable over Shiraishi at least because these claims include all the limitations recited in independent claims 25 and 33, respectively. Favorable consideration of the new claims is, therefore, respectfully solicited.

**Shiraishi (U.S. Patent Application Publication No. US 2003/0107609)**

As discussed above, Shiraishi does not disclose the claimed invention under 35 U.S.C. §102(e). It is noted that Shiraishi is also entitled to be prior art to the present application under 35 U.S.C. §102(a) because Shiraishi was published on June 12, 2003, while the present

application was filed on February 10, 2004. However, Applicants note that Shiraishi cannot be prior art to the present application under 35 U.S.C. §103(a) in a subsequent Office Action, for the reason set forth below.

According to in M.P.E.P. § 2146, a reference that qualifies as “prior art” only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention.

Applicants have submitted a certified English translation of the Japanese priority documents No. 2003-69790 to perfect the priority date of the present application, March 14, 2003. Therefore, since the effective filing date of the present application is March 14, 2003, Shiraishi, published June 12, 2003, and filed March 13, 2001, is available as prior art only under 35 U.S.C. §102(e). Applicants further state that the present Application and Shiraishi were, at the time the invention of the present Application was made, commonly owned by Dainippon Screen Mfg. Co., Ltd. of Kyoto, Japan. Therefore, under 35 U.S.C. § 103(c), Shiraishi cannot be considered by the Examiner when determining whether Applicants’ invention is obvious under 35 U.S.C. §103.

Applicants respectfully request the Examiner to consider the above fact if Shiraishi is cited to reject the claims under 35 U.S.C. § 103(a) in a subsequent Office Action.

### **Conclusion**

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

**Application No.: 10/774,538**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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WDC99 1310005-1.058604.0033